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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,630	11/07/2001	Yuji Toyomura	MAT-8198US	4831

7590 08/10/2007
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EXAMINER

LE, DEBBIE M

ART UNIT	PAPER NUMBER
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2168

MAIL DATE	DELIVERY MODE
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08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/010,630	TOYOMURA ET AL.	
	Examiner	Art Unit	
	DEBBIE M. LE	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,12 and 14-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,12 and 14-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Appeal Brief filed on April 19, 2007, prosecution is hereby reopened. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

1) file a reply under 37 CFR 1.111 (if this office action is a non-final) or a reply under 37 CFR 1.113 (if this office is a final); or

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

A handwritten signature in black ink, consisting of a large, stylized 'Z' or 'S' shape followed by a smaller, more complex signature.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8/2/07 have been considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-6, 8-, 12, 14-58, 65-70, 77-82 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 non-statutory above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 5, 50 and 51, 52, 53-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Black et al (US patent 7103602 B2) (hereinafter "Black").

As per claim 1, Black disclose [a] memory media (CD, backup tapes, hard drives, floppies, optical, etc.) comprising:

a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats (a directory stores e-mail and another directory stores user data files) (Fig. 3, elements 56, and 60);

a further directory at said directory level, said further directory for storing files in other than said plurality of file formats (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40).

As per claim 3, Black teaches wherein said directory level is immediately under a root directory (col. 5, line 24, a user directory).

As per claim 5, Black teaches wherein said further directory is further for storing files in one of said plurality of file formats (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40).

As per claim 50, Black teaches wherein said further directory is also for storing at least said respective file format (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40).

As per claim 51, Black teaches wherein files in said further directory are independent and without links relative to files in said further of directories (as each directory stores its own data file type format (col. 5, lines 24-27, 35-40).

Claims 52, 53, 56, 54, 55 and 57 are rejected under the same rationale as stated in claim 1 arguments. Furthermore, claim 54 and 55, Black further teaches determining the file is not capable of being stored in the limited directory (Fig: 1, # 26, stores receives data file and organize them in to a file database 26, which are not yet categorized).

As per claim 58, Black teaches wherein said directory level is immediately under a root directory (col. 6, lines 55-67).

As per claim 59, Black teaches apparatus which is capable of controlling a carryable memory media, comprising:

a CPU operable to instruct to store a file obtained from the carryable memory media (Fig. 1, element 22, server processor);

a controller operable (Fig. 1, element 24, file organizing processor) to form a directory in the carryable memory media and operable to store the obtained file in the carryable memory media (directory file type in CD, floppy disk), wherein if a directory formed by an other apparatus is stored in the carryable memory media and there is not a directory formed by the apparatus in the carryable memory media (Fig. 1, data file 1 through data file N, received from another system), the apparatus makes the carryable memory media form a new directory which is allowed to store an arbitrary file stored in the memory and store the obtained file in the new directory (Fig. 1, element 28, 26, file logging processor (categorize) the data file 1 through data file N into a file database 26 directory).

Claims 60-64, 66-70, 72-76 have similar limitations as claims 12, 14-24, therefore, they are rejected under the same subject matter.

Claims 65, 71 are rejected under the same rationale as stated in claim 59 arguments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 6, 8, 12, 14-31, 32-48, 77-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black et al (US patent 7103602 B2) (hereinafter "Black") in view of lida (US patent 6,662,269 B1 (hereinafter "lida")).

As per claim 4, Black does not explicitly teach wherein the memory media are memory cards, but lida teaches memory media is memory card (col. 19, lines 1-4). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to have a memory media is a memory card as disclosed by lida because the memory card is is relatively small removable memory that provide data storage, and it is integrated circuit bases so that it can plugs into or is received by ports or connectors on electronic devices, including computing devices, cameras, mobile telephones, PDA, such data stored in the memory card is connected to the system (i.e., a portable terminal) is more easily handled by a user.

As per claim 6, Black discloses memory media detachable to and from a terminal (hard drive, a floppy disk, CD, col. 1, lines 30-31), comprising

means for forming a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats (a directory stores e-mail and another directory stores user data files) (Fig. 3, elements 56, and 60),

a further directory at said directory level, said further directory for storing files in other than said plurality of file formats (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40).

Black does not explicitly teach a portable information terminal. But lida teaches a portable information terminal (Fig. 2, element 20, PDA). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to have a portable information terminal comprising memory media detachable to and from a terminal body of the information terminal to store each of said directories limited to storing files of a respective one of a plurality of file formats in the memory media because the memory media detachable to and from the portable terminal is relatively small removable memory that provide data storage, and it is integrated circuit bases so that it can plugs into or is received by ports or connectors on electronic devices, including computing devices, cameras, mobile

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telephones, PDA, such data stored in the memory media is connected on the portable terminal is more easily handled by a user.

As per claim 8, Black discloses carryable memory media detachable to and from (hard drive, a floppy disk, CD, col. 1, lines 30-31), wherein said carryable memory media is provided with

a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats (a directory stores e-mail and another directory stores user data files) (Fig. 3, elements 56, and 60),

a further directory at said directory level, said further directory for storing files in other than said plurality of file formats (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40),

if a file to be stored conforms to said plurality of directories, said portable information terminal stores the relevant file in the carryable memory media at a data area corresponding to one of said plurality of file formats (col. 5, lines 35-40, the data files having the same file type can be grouped and stored together in the in a database structure),

if a file to be stored does not conform to said portable information terminal stores the file in the carryable memory media at a further data area corresponding to said further directory (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word

format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40).

Black does not explicitly teach a portable information terminal. But lida teaches a portable information terminal (Fig. 2, element 20, PDA). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to have a portable information terminal comprising memory media detachable to and from a terminal body of the information terminal to store each of said directories limited to storing files of a respective one of a plurality of file formats in the memory media because the memory media detachable to and from the portable terminal is relatively small removable memory that provide data storage, and it is integrated circuit bases so that it can plugs into or is received by ports or connectors on electronic devices, including computing devices, cameras, mobile telephones, PDA, such data stored in the memory media is connected on the portable terminal is more easily handled by a user.

As per claim 12, Black teaches wherein an attached file attached to electronic mail received is stored in said carryable memory media at a data area corresponding to said further directory (Fig. 3, element 56).

As per claim 14, Black teaches an operation section for operation by a user, wherein based on operation by said user of the operation section, at least one file is stored in a data area corresponding to said plurality of directories and at least another file is stored In a further data area corresponding to said further directory (col. 5, lines 1-10).

As per claim 15, Black teaches separation means for separating an e-mail with the attached file received through said communication means into the e-mail document file and the attached file (Fig. 3, element 56), wherein

said e-mail document file is stored in said carryable memory media at a data area corresponding to one of said plurality of formats (col. 6, lines 49-52), and

said attached file is stored in said carryable memory media at a data area corresponding to other than said plurality of formats (col. 6, lines 55-56).

As per claim 16, Black teaches wherein storage of said e-mail document file and said attached file is based on operation of a user (col. 5, lines 4-5).

As per claim 17, Black teaches file extraction means for extracting said files (col. 6, lines 57-64).

As per claim 18, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file for deleting the file, shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there, transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44, de-duplicating).

As per claim 19, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file expansion index (col. 7, lines 10-25).

As per claim 20, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, based on the file inner structure (col. 7, lines 10-25).

As per claim 21, Black teaches wherein said file extraction means extracts the file that conforms to said specific file form, through a plurality of steps of extraction (col. 7, lines 10-25).

As per claim 22, Black teaches input means for inputting conditions for file extraction, wherein said file extraction means extracts, among those which conform to said specific file form, the file that satisfies said conditions for file extraction (col. 7, lines 1-9).

As per claim 23, Black teaches control means, wherein said control means controls at least one process among the following processes to be performed on said extracted file, for deleting the file; shifting the file to a data area of said carryable memory media, which data area corresponding to a different directory other than the original directory, and storing it in there; transmitting the file as an attached file; and exhibiting it on a display (Fig. 2, element 44).

As per claim 24, Black teaches wherein said file extraction means extracts the file that conforms to specific file form through the following process; a primary extraction based on the file expansion index, and an extraction once again based on the inner structure of those extracted by said primary extraction (Fig. 3, element 56, 58, e-mail file type and attached data file type).

As per claim 25, lida teaches a video processing function, said directory for storing specific format files containing a directory for storing video information form files, wherein a video information file is extracted from both of the data areas of said carryable memory media; one data area is that which corresponds to the directory for storing video information form files and the other data area is that which corresponds to said directory for storing non-specific format files (col. 17, lines 30-51).

As per claim 26, Black teaches terminal extracts the Exif format image file through either one of the following processes; extracting the JPG image file from data area of said carryable memory media based on the directory for storing non-specific format files, or extracting the image file from said carryable memory media based on the JPG expansion index . jpg of the directory for storing non-specific format files; and a process of checking the Inner structure of said image file extracted (col. 8, lines 35-67).

As per claim 27, Black teaches information terminal prints the extracted Exif format file upon an operation made by a user (col. 9, lines 20-22).

As per claim 28, Black teaches wherein the portable Information terminal transmits the attached file stored in a data area corresponding to said further directory via said communication means, accompanying an e-mail (col. 6, lines 47-52).

As per claim 29, Black teaches wherein said file control means deletes a file which had been stored in a data area corresponding to said further directory after it is transmitted via said communication means (Fig. 2, # 44, de-duplicating).

As per claim 30, Black teaches wherein said file control means shifts a file that had been stored in a data area corresponding to said directory for storing non-specific format files after it was transmitted via said communication means, to a data area of said carryable memory media that corresponds to a certain directory other than said original directory for storing specific format files and said original directory for storing non-specific format files (a master user list, folder directory (root), col. 6, lines 49-50).

As per claim 31, Black teaches wherein said instruction means issues one of the following instructions based on operation of the operation section by a user, after a file stored in a data area corresponding to said directory for storing non-specific format files is transmitted via said communication means, regarding how the transmitted file be handled:

leaving the transmitted file in said directory for storing non-specific format files;

deleting the transmitted file (Fig. 2, de-duplicating);

shifting the transmitted file to a data area of said carryable memory media that corresponds to a certain specific directory other than said original directory for storing specific format files and said original directory for storing nonspecific format files.

As per claim 32, Black discloses [a] method for managing files carryable memory media detachable to and from, comprising the steps of:

A) forming a plurality of directories at a directory level, each of said directories limited to storing files of a respective one of a plurality of file formats (a directory stores e-mail and another directory stores user data files) (Fig. 3, elements 56, and 60),

B) forming a further directory at said directory level said further directory for storing files in other than said plurality of file formats (as the directory stores e-mails contains attached files such as images data file and the directory stores user data files such as Word format, Excel format, wherein the data files having the same file type can be grouped and stored together in the in a database structure (col. 5, lines 24-40), and

C) storing a file in said carryable memory media at a data area corresponding to one of said plurality of directories or said further directory (col. 1, lines 20-24, 30-33).

Claims 34-43 have similar limitations as claims 12, 14-24, therefore, they are rejected under the same subject matter.

Claims 46-48 have similar limitations as claim 3, therefore, they are rejected under the same subject matter.

Claim 49 is rejected under the same rationale as stated in claim 6 argument.

Claim 77 is rejection by the same rationale as stated by claim 59. Furthermore. However, Black does not explicitly teach a memory card slot. But

lida teaches memory card slot (col. 1, lines 55-59). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to have memory card insert into memory media because the memory media detachable to and from the portable terminal is relatively small removable memory that provide data storage, and it is integrated circuit bases so that it can plugs into or is received by ports or connectors on electronic devices, including computing devices, cameras, mobile telephones, PDA, such data stored in the memory media is connected on the portable terminal is more easily handled by a user.

Claims 78-82 have similar limitations as claims 12, 14-24, therefore, they are rejected under the same subject matter.

Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black et al (US patent 7103602 B2) (hereinafter "Black") in view of lida (US patent 6,662,269 B1 (hereinafter "lida"). and further in view of Ito et al (US Patent Application Pub. No. 2005/0219559 A1).

As per claim 44, Black and lida does not explicitly teach wherein the portable Information terminal is a portable telephone unit. But Ito teaches the portable Information terminal is a portable telephone unit (para. 0140). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to combine the teachings of the cited references to implement the portable Information terminal is a portable telephone unit because it would provide users of Black and lida's system to

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retrieve and/or transmit a file (picture) from a small directory (memory card's directory from the mobile phone) even without a digital camera.

Claim 45 has similar limitation as claim 44, therefore, it is rejected under the same subject matter.

Conclusion

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M. LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DEBBIE LE
PRIMARY EXAMINER

8/6/07